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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,173	09/29/2005	Ken'ichi Fujii	00862.023538.	4237
5514 7590 07/28/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
NEURAUTER, GEORGE C				
ART UNIT		PAPER NUMBER		
2443				
MAIL DATE		DELIVERY MODE		
07/28/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,173

Applicant(s)

FUJII ET AL.

Examiner

George C. Neurauter, Jr.

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/IC)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :30 September 2008, 22 June 2009, and 1 July 2009 .

DETAILED ACTION

Claims 1-4 and 6-16 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 July 2009 has been entered.

Information Disclosure Statement

The IDSes filed 30 September 2008, 22 June 2009, and 1 July 2009 are in compliance with 37 CFR 1.97 and 1.98 and have been considered by the Examiner.

Response to Arguments

Applicant's arguments filed 1 July 2009 have been fully considered but they are not persuasive.

The Applicant argues Serceki does not teach or suggest wherein an operator specifies a predetermined data processing function for a wireless communication device as recited in claim 1. The Examiner respectfully disagrees in view of the broadest reasonable interpretation of the claim. Since the claim fails to recite and therefore require that the operator specify the function in a specific and particular way, it may be interpreted that the operator specifies the function in a non-computerized way including merely mentally deciding that the operator wishes to search for a wireless

communication device having a predetermined data processing function such as connecting to a network wirelessly. Therefore, Serceki does teach this limitation in its broadest sense.

The same rationale is cited for the Applicant's arguments regarding the "discrimination unit", "determination unit" and "display unit" as recited in claim 11. The discrimination unit in its broadest sense is part of the system of Serceki since the system of Serceki is for the purposes of connecting wirelessly to a network, which is the processing function designated by the operator when the operator chooses to use the system of Serceki with a general purpose computer.

The Applicant also argues that "Zero" does not teach or suggest a wireless communication device that can switch between a history search mode and a new search mode, and executes a communication process in each mode, wherein, in the history search mode, the wireless communication device communicates with a partner wireless communication device that had been communicated with previously, and wherein, in the new search mode, the wireless communication device communicates with a newly searched for partner wireless communication device that includes a "search unit adapted to, in the history search mode, compare network identification information included in the detected beacon with the network identification information stored in said storage unit, cause said detection unit to detect another beacon, if there is a match in the compared network identification information, and search for a partner wireless communication device to communicate with based on new network identification information, if the new network identification information is detected," and

"a first display unit adapted to, in the new search mode, selectively display device identification information of a wireless communication device found by said search unit," as recited in Claim 10. The Applicant contends that "the Wireless Zero Configuration Service is not understood to perform the functions of the claimed search unit and first display unit. That is, there is no display area that lists only information regarding devices to which the computer has not connected previously."

The Examiner respectfully disagrees.

Zero disclosed:

"The first time a wireless adapter is added to a computer running Windows XP, the WZC service prompts you with the "One or more wireless networks are available" message in the notification area, which leads you to select a wireless network by using the Wireless Network Connection dialog box. After you select a wireless network and the connection is successful, the selected network is automatically added as a preferred network, and you are no longer prompted with the "One or more wireless networks are available" message whenever you are within range of it. For an organization, this is the typical process for configuring the initial connection to a private wireless network. After the initial configuration, the WZC service connects (then maintains the connection to) the organization wireless network. When you take your laptop computer to an airport or another location with public wireless access, the WZC service first attempts to connect to your preferred network. When that connection attempt fails, you are prompted again with the "One or more wireless networks are available" message to connect to the public access wireless network." (see page 4 of "Zero")

"Zero" expressly discloses that the device switches between a history search mode and a new search mode and that, while in the new search mode, a list of available networks are displayed. Since the device is not in the vicinity of one of the previously found partner wireless communication devices that were attempted to be found in the "history search mode", the only partner wireless communication devices that are displayed are those that were not found before and are considered to be found in the "new search mode". Therefore, "Zero" does disclose these limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-9, 11-13, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication 20040102192 to Serceki.

Regarding claim 1, Serceki disclosed a wireless communication system having first and second wireless communication devices, wherein said first wireless communication device ("wireless station" including a "wireless monitoring application") comprises:

a detection unit adapted to detect a plurality of beacons at a plurality of frequencies; a connection unit adapted to connect to a network identified by network

identification information included in a beacon ("SSID") detected by said detection unit to search for a wireless communication device having a predetermined data processing function specified by an operator (the system providing Internet services); a first transmission unit adapted to transmit a search request signal (attempt to "associate"), to search for the wireless communication device having the predetermined data processing function specified by the operator, to a wireless device on the network connected to by said connection unit;

a determination unit adapted to determine whether the wireless communication device ("access point") on the network connected to by said connection unit has the predetermined data processing function specified by the operator on the basis of a response signal (response to the attempt to "associate") that the wireless communication device on the network connected to by said connection unit has transmitted in response to the search request signal transmitted by said first transmission unit;

a display unit adapted to selectably display information associated with the wireless communication device determined by said determination unit to have the predetermined data processing function specified by the operator so as to determine a wireless communication partner; and

a control unit adapted to, when the operator selects the information displayed by said display unit while said detection unit performs a detection process to detect the beacon, terminate the detection process of said detection unit and execute connection

processing with a wireless communication device specified by the selected information, and

said second wireless communication device (the "access point") comprises:

a second transmission unit adapted to transmit a signal including self identification information as the response signal (response to attempt to "associate" providing information on how to connect to the device), when search request information is detected in a wireless reception waiting state at a predetermined frequency. (see at least paragraphs 0011 and 0012)

Claims 2 and 13 are also rejected since these claims recite in whole or in part substantially the same limitations as recited in claim 1.

Regarding claim 3, Serceki disclosed the device according to claim 2, wherein said determination unit stores in a memory identification information of a wireless communication device on a partner side included in a response signal to the search request signal upon reception of the response signal, and said display unit selectably displays the identification information stored in the memory. (see at least paragraphs 0011 and 0012)

Regarding claim 6, Serceki disclosed the device according to claim 2, wherein when no signal is received in response to the search request signal within a predetermined period of time, an error display is made. (see at least paragraphs 0011 and 0012) (if no partner wireless communication device is found, the user would inherently discover over a user selected period of time that no device is available and

that the display's lack of showing an available device is indicative of such an error that no device is available)

Regarding claim 7, Serceki disclosed the device according to claim 2, further comprising: a second determination unit adapted to determine if the beacon detected by said detection means is a beacon in an adhoc communication mode or a beacon in an infrastructure communication mode, and when said second determination unit determines that the detected beacon is the beacon in the adhoc communication mode, said transmission unit transmits the search request signal toward a wireless communication processing device as a generation source of the detected beacon, and when said second determination unit determines that the detected beacon is the beacon in the infrastructure mode, said transmission unit transmits the search request signal toward an access point. (see at least paragraphs 0007, 0008, and 0011)

Regarding claim 8, Serceki disclosed the device according to claim 2, further comprising registration unit adapted to register, in a memory, information associated with connection to the partner, wireless communication device, to which a wireless communication has been established. (see at least paragraph 0034) (the wireless station uses the information in a beacon frame to associate with the access point and stores the information for the connection)

Regarding claim 9, Serceki disclosed the device according to claim 8, further comprising a mode for executing a process for establishing a wireless communication on the basis of the information registered by said registration unit. (see at least paragraph 0034)

Regarding claim 11, Serceki disclosed a wireless communication system having first and second wireless communication devices, wherein said first wireless communication device comprises: a discrimination unit adapted to discriminate a type of device capable of executing a processing function designated by an operator; a determination unit adapted to, when receiving a beacon transmitted by a device on a wireless network, determine whether device identification information corresponding to the type discriminated from said discrimination unit is included in the received beacon; and a display unit adapted to selectably display information associated with the device that transmitted the beacon, in accordance with a determination result determined by said determination unit, and said second wireless communication device comprises: an informing adapted to include device identification information indicating a function into a beacon and transmitting the beacon to the wireless network, and when information of said second wireless communication device among information displayed by said display unit is selected, a process for establishing a communication between said first and second wireless communication devices is executed. (see at least paragraphs 0011 and 0012)

Claims 12 and 15 are also rejected since claims 12 and 15 recite substantially the same limitations as recited in claim 11.

Regarding claim 16, Serceki disclosed the device according to claim 2, wherein said predetermined data processing function includes at least one of a data printing function and a data saving function. (the "access point" provides Internet services, that may include saving of data at a remote location or at the access point itself for saving

the connection information of the wireless communication device connecting to the "access point")

Claims 10 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by "The Windows XP Wireless Zero Configuration Service" ("Zero").

Regarding claim 10, "Zero" disclosed a wireless communication device (computer executing the Windows XP operating system including the Windows XP Wireless Zero Configuration Service) that is configured to switch between a history search mode and a new search mode, and executes a communication process in each mode, wherein, in the history search mode, the wireless communication device communicates with a partner wireless communication device that had been communicated with previously, and wherein, in the new search mode, the wireless communication device communicates with a newly searched for partner wireless communication device comprising:

A storage unit (contained on the computer) adapted to store device identification information and network identification information of a partner to which the wireless communication device has been connected previously ("preferred network"; see also "Preferred Networks" on page 2); an instruction unit adapted to instruct one of the history search mode and the new search mode; a beacon detection unit that operates in the new search mode and that detects a beacon; a search unit adapted to, in the history search mode, compare network identification information included in the detected beacon with the network identification information stored in said storage unit, cause said detection unit detect another beacon if there is a match in the compared network

identification information, and search for a partner wireless communication device to communicate with based on new network identification information if the new network identification information is detected; a first display unit adapted to, in the new search mode, selectably display device identification information of a wireless communication device found by said search unit; a second display unit adapted to selectably display the device identification information of a wireless communications device stored in said storage unit in response to said instruction unit instructing the history search mode; and a wireless communication establishment process unit adapted to, when device identification information displayed by one of said first and second display unit is selected, execute a wireless communication establishment process with the wireless communication device specified by the selected device identification information. (see "preferred networks" on page 3 and "How the WZC service works on pages 4 and 5) (see also plural displayed windows on pages 2 and 3)

Claim 14 is also rejected since claim 14 recites substantially the same limitations as recited in claim 10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serceki in view of US Patent 6,529,522 to Ito et al.

Regarding claim 4, Serceki disclosed the device according to claim 2.

Serceki did not expressly disclose wherein each of the wireless communication device and the partner wireless communication device comprises one of an image sensing device, a device for executing a print process of a sensed image, and a storage device for executing a storage process of a sensed image, however, Ito did disclose these limitations (see at least column 8, lines 19-62)

It would have been obvious to one of ordinary skill in the art the time the invention was made to combine the teachings of these references since both references disclose analogous subject matter regarding wireless communication devices and their connections with partner wireless communication devices and one of ordinary skill would have found that the substitution of a wireless communication device and a partner communication device with the image sensing device and a device for executing a print process of a sensed image would not introduce any unforeseen changes in the operation of the device of Serceki regarding wireless communications and would have reasonably predicted a successful combination of the wireless functionality of Serceki and the image sensing device and the device for executing a print process of a sensed image described in Ito.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C Neurauter, Jr./
Primary Examiner, Art Unit 2443